

### **REMARKS**

Applicant has carefully reviewed the Office Action dated May 28, 2004. All pending claims have been rejected. Claims 1-5, 8, 11-14 and 16 have been amended, claim 6 has been cancelled and 7, 9, 10, 15, 17 and 18 were previously withdrawn from consideration. Claims 19-22 remain in their original form.

Claims 1-6, 8, 11-14 and 16 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. All of these claims have been amended. Claim 1 now clearly refers to a balloon for a balloon catheter with several elements. The second phrase, which begins "wherein the plurality of voids..." is a phrase to structurally describe the voids that are part of the balloon. Applicant asserts that as amended this is not a product-by-process claim element. Claim 11 is also drawn to a balloon for a balloon catheter. Additionally, the balloon waist has a material volume per unit length, and this material volume per unit length is achieved by removing material from the balloon waist. The removed material is itself a structural limitation. With these amendments, Applicant asserts that the subject matter recited in claims 1 and 11 is now clear and 35 U.S.C. §112, second paragraph is thus complied with. Possible references to the finished balloon dilatation catheter have also been removed from the dependent claims, and the dependent claim preambles have been amended. Thus, Applicant asserts that claims 1-5, 8, 11-14 and 16 now comply with 35 U.S.C. §112.

Claims 1-6, 8, 11-14 and 16 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Sugiyama et al., U.S. Patent 4,964,853 (hereinafter Sugiyama). Applicant respectfully traverses this rejection. All elements are required to be present in the prior art for either a §102(b) or a §103(a) rejection. See

M.P.E.P. §2131 and §2143.03. Sugiyama discloses a catheter equipped with an expansible member. Sugiyama does not disclose a balloon waist that has a plurality of voids or has material removed from it. Amended claims 1 and 11 claim a balloon that is for a balloon dilation catheter. Claim 1 states that the balloon waist has a plurality of voids and claim 11 states that the balloon waist has material removed from it in order to achieve a material volume per unit length. Sugiyama does not describe such balloon waist structures. Because elements of claims 1 and 11 are missing from the cited reference, Applicant asserts that Sugiyama does not anticipate or render obvious claims 1 or 11. In addition, Applicant asserts that claims 2-6, 8, 12-14, and 16 are also allowable, because they depend on allowable claims 1 and 11 and recite additional patentably distinct elements.

Claims 19-22 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Cornelius, U.S. Patent 5,649,909 (hereinafter Cornelius). Applicant respectfully traverses this rejection. All elements are required to be present in the prior art for either a §102(b) or a §103(a) rejection. *See* M.P.E.P. §2131 and §2143.03. Cornelius does not disclose a balloon waist with voids or a balloon waist with material removed. The portions of the specification cited in the Office Action show this. The voids that are referred to in column 7, lines 40-45 are voids between the inner surface of the balloon waists (54 and 63) and the outer surface of the shaft 36. This is simply what occurs when one non-porous surface is placed on another non-porous surface – air pockets can form between them, forming voids. These are not voids in the balloon waist, but are voids between the inner surface of the balloon waists (54 and 63) and the outer surface of the shaft 36. This part of the specification then goes on to state that an adhesive that flows into these voids is desirable. Claim 1 clearly recites that the voids are in the balloon waist, and claim 11 clearly

recites that material is removed from the balloon waist. Neither of these elements is disclosed in the Cornelius specification. Because elements of claim 19 are missing from the cited reference, Applicant asserts that Cornelius does not anticipate or render obvious claim 19. In addition, Applicant asserts that claims 20-22 are also allowable, because they depend on allowable claim 19 and recite additional patentably distinct elements.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

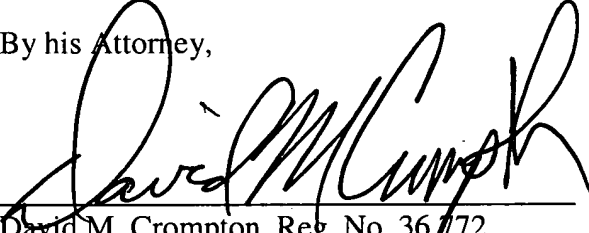
Respectfully submitted,

Matthew Heidner

By his Attorney,

Date: \_\_\_\_\_

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